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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,108	11/28/2001	Johan Loccutier	27500-11	2519

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT PAPER NUMBER

1762

8

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/996,108

Applicant(s)

LOCCUFIER ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached Detailed Advisory Action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Detailed Advisory Action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 11.

Claim(s) rejected: 1-10.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

William Phillip Fletcher III
Patent Examiner, USPTO
Group Art Unit 1762

Detailed Advisory Action

The examiner prepares this advisory action in reply to applicant's response after final,
5 timely filed 31 March 2003, made of record in this file as Paper No. 7.

Applicant's proposed amendment will not be entered because it raises new issues that would require further consideration and search. Claim 1, if amended as proposed, would recite "...with the proviso that R3 and R4 are not polyolefin." This limitation would narrow the scope of the claim and has not been heretofore searched or considered by the examiner. Further, since
10 the amendment presents additional claims (12 - 20) without canceling any finally rejected claims, it does not place the application in better condition for appeal. See *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

The examiner fully considered applicant's arguments in Paper No. 7. The arguments are not persuasive.

15 Applicant's arguments with respect to the rejection of claims 1 - 6 under 35 U.S.C. § 102(e) are drawn to claim 1 if amended as-proposed. Since the proposed amendment to claim 1 will not be entered, these arguments are moot.

Applicant argued that Breton is directed to acoustic ink jet printing on paper and, consequently, there is no intention of using the inks of Breton on a metal surface: therefore the
20 ability, or lack thereof, of oleophilizing a metal surface is not contemplated. The examiner notes that applicant has not claimed the nature of the lithographic printing plate; paper, metal, or otherwise. Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the disclosure of Breton is directed broadly to acoustic ink jet printing, and suitable inks therefore, compatible with a wide variety of substrates, of which plain paper is only an example [c. 5, ll. 27 - 30]. There is no evidence that acoustic ink jet ink compositions, having imidazoline viscosity-modifying compounds, are limited to paper substrates, or that coating a metal substrate with these inks would/could not work — particularly in light of the fact that Breton teaches adjusting properties (such as viscosity) of acoustic ink jet inks to control coating characteristics and that ink jet printing on metal substrates is known (see Zerillo, for example). Consequently, this argument is not convincing.

Applicant argued that one of ordinary skill in the art would not have chosen one single compound from among the many in the lengthy disclosure of Breton, absent hindsight reasoning. The examiner notes that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is the examiner's position that it would have been obvious to one of ordinary skill to deposit the fluid of Zerillo by the acoustic ink jet method disclosed by Breton with the desire and expectation of improved resolution and greater reliability, as explicitly disclosed by Breton. Further, it would have been obvious to utilize, as the fluid, an ink with an imidazoline viscosity-modifying compound, based on the explicit suggestion to do so by Breton. The explicit suggestion of Breton comes from c. 9,

11. 4 - 6, where a short list of five viscosity-modifying agents — including 2-methyl-2-imidazoline — is taught. Consequently, this argument is not convincing.

Applicant argued that, even if the combination of Zerillo and Breton were made, one would not be expected to use a viscosity compound from ink specific to improve the properties of an image on paper as an oleophilizing compound on a metal surface. Applicant further argued that, nowhere in the cited art is there any teaching that would lead a skilled artisan to correlate the properties of imaged paper with the ability of a compound to act as an oleophilizing agent. The examiner notes that, as stated in Paper No. 6, since the viscosity-modifying compound forms an integral part of the ink composition and remains on the receiving layer to form the ink-receptive image, it is the examiner position that the viscosity-modifying compound is an integral part of the oleophilizing compound — thereby serving to oleophilize the surface of the lithographic receiver — and, since it has an amidine functional group in its chemical structure, meets applicant's claimed limitation of an oleophilizing compound having in its chemical structure an amidine functional group. Consequently, this argument is not convincing.

15 With respect to applicant's arguments traversing the rejection of claim 7, the disclosure of Breton is directed broadly to acoustic ink jet printing, and suitable inks therefore, compatible with a wide variety of substrates, of which plain paper is only an example [c. 5, ll. 27 - 30]. There is no evidence that acoustic ink jet ink compositions, having imidazoline viscosity-modifying compounds, are limited to paper substrates, or that coating a metal substrate with these inks would/could not work — particularly in light of the fact that Breton teaches adjusting properties (such as viscosity) of the inks to control coating characteristics and that ink jet

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printing on metal substrates is known (see Zerillo, for example). Consequently, this argument is not convincing.

Applicant argued that the present invention specifically excludes polymers. The examiner notes that the limitation excluding polyolefins as-proposed will not be entered. Otherwise, the claims currently do not exclude polymeric inks or oleophilizing compounds. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Consequently, this argument is not convincing.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (703) 308-7956. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

William Phillip Fletcher III
Patent Examiner
United States Patent & Trademark Office
Group Art Unit 1762

wpf
April 11, 2003


SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
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